

REMARKS

This communication responds to the Office Action mailed on May 11, 2009.

Claims 1-4, 6, 10, 32, 36-40, 50-54 and 61-62 are amended, claims 19, 25-31, 49 and 55-60 are canceled, and no claims are added in this communication. As a result, claims 1-18, 20-24, 32-48, 50-54 and 61-62 are now pending in this application.

§101 Rejection of the Claims

Claims 1-60 were rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter.

Independent claim 1:

Applicants have amended independent claim 1 to read as follows:

1. A method to facilitate a transaction via a network-based transaction facility, the method including:
 recording a pre-order relating to an item in a processor-implemented database of the transaction facility, the pre-order specifying a plurality of pre-order attributes including a minimum pre-order product condition and minimum seller rating;
 receiving an offer to sell the item at the transaction facility, the offer specifying a plurality of offer attributes including an offer product condition and a seller rating;
 automatically performing with processor-implemented matching logic a matching operation to detect a correspondence between the pre-order and the offer, the matching operation utilizing the plurality of pre-order attributes and the plurality of the offer attributes to detect the correspondence; and
 responsive to the processor-implemented matching logic detecting a correspondence between the pre-order and the offer, automatically performing a transaction when the plurality of pre-order attributes are satisfied by the plurality of the offer attributes.

As amended, independent claim 1 is tied to, for example, a processor-implemented database of the transaction facility and processor-implemented matching logic, which are components (belonging to another statutory class), and thus claim 1 satisfies the “machine-or-

transformation” test. Applicants thus believe that amended independent claim 1 (as well as its dependent claims) is directed to statutory subject matter.

Independent claims 25, 31 and 55:

Applicants have canceled independent claims 25, 31 and 55. The rejection of independent claims 25, 31 and 55 (as well as their dependent claims) under 35 U.S.C. §101 is thus moot now.

Reconsideration and withdrawal of the rejection of amended independent claim 1 (as well as its dependent claims) under 35 U.S.C. § 101 are respectfully requested.

§112 Rejection of the Claims

Claims 1-24, 31-44 and 55-60 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite.

Independent claim 1:

The Office Action, on page 4, asserts, “**Re claim 1:** *The following limitation is indefinite: responsive to a detection of the correspondence by the matching operation, automatically performing a transaction facilitating operation to facilitate establishment of a transaction whereby the pre-order is satisfied by the offer to sell the item. The scope of the claim is unclear because the claim is not positively reciting if a transaction takes place based on the matching operation. Is the transaction taking place or not?*”

Applicants have amended independent claim 1 to recite, in part, “responsive to the processor-implemented matching logic detecting a correspondence between the pre-order and the offer, **automatically performing a transaction** when the plurality of pre-order attributes are satisfied by the plurality of the offer attributes.” Applicants thus believe that amended independent claim 1 is definite.

Independent claims 31 and 55:

Applicants have canceled independent claims 31 and 55. The rejection of independent claims 31 and 55 (as well as their dependent claims) under 35 U.S.C. §112, second paragraph, as being indefinite is thus moot now.

Reconsideration and withdrawal of the rejection of amended independent claim 1 (as well as its dependent claims) under 35 U.S.C. §112, second paragraph, as being indefinite are thus respectfully requested.

§103 Rejection of the Claims

Claims 1-2, 6-17, 19, 21-32, 36-47, 49 and 51-62 were rejected under 35 U.S.C. §103(a) as being obvious over Gillman (U.S. Publication No. 2002/0147674).

Claims 3-4 and 33-34 were rejected under 35 U.S.C. §103(a) as being obvious over Gillman in view of Force (U.S. Patent No. 6,704,716).

Claims 5 and 35 were rejected under 35 U.S.C. §103(a) as being obvious over Gillman in view of Godin (U.S. Patent No. 5,890,138).

Claims 18 and 48 were rejected under 35 U.S.C. §103(a) as being obvious over Gillman in view of Pepin (U.S. Publication No. 2002/0042835).

Claims 20 and 50 were rejected under 35 U.S.C. §103(a) as being obvious over Gillman in view of Fickes ("Waste Web", Waste Age, Overland Park: August 2000, Volume 31, Issue 8, Page 556, 9 pages).

Independent claims 1, 61 and 62:

Applicants respectfully submit that Gillman does not disclose the limitation of *"responsive to the processor-implemented matching logic detecting a correspondence between the pre-order and the offer, automatically performing a transaction when the plurality of pre-order attributes are satisfied by the plurality of the offer attributes"*, which has been added into independent claim 1 from modified claim 19.

When rejecting original claim 19, the Office Action, on page 8, asserts, "**Re claim 19:** Gillman disclose automatically establishing the transaction whereby the pre-order is satisfied by the offer when all of the pre-order attributes are satisfied by the offer attributes. –see para. 49. " Applicants disagree. Referring to para. 49 of Gillman (relied upon by the Office Action), no **automatically establishing a transaction** is found. In contrast to claim 19, in Gillman, after identifying the suppliers, **the buyer may choose a winner of the auction** to provide the forging (rather than **automatically establishing a transaction** when the plurality of pre-order attributes

are satisfied by the plurality of the offer attributes as claimed in amended independent claim 1). Accordingly, Gillman and amended claim 1 adopt different approaches. See para. 49 of Gillman (with emphasis added),

[0049] After identifying the suppliers, **the buyer may choose a "winner" of the auction** to provide the forging according to agreed terms. **The buyer choosing a winner of the auction** is preferably not limited to selecting the supplier that has bid the lowest price and/or the best delivery terms. As is the custom in the general forging industry, **the buyer is free to choose any of the suppliers who bid on the RFQ, regardless of the terms specified.** In these specialized industries, external factors (such as reputation for craftsmanship/promptness or prior history) may outweigh the absolute benefits of low price and favorable delivery terms.

Accordingly, Applicants respectfully submit that Gillman fails to disclose the feature of *“responsive to the processor-implemented matching logic detecting a correspondence between the pre-order and the offer, automatically performing a transaction when the plurality of pre-order attributes are satisfied by the plurality of the offer attributes”* as recited in amended independent claim 1. For at least this reason, Applicants respectfully submit that amended independent claim 1 (as well as its dependent claims) is nonobvious over Gillman.

The above argument presented with respect to amended independent claim 1 also applies to amended independent claims 61 and 62, which respectively have features similar to the above quoted feature of amended independent claim 1. Accordingly, Applicants respectfully submit that amended independent claims 61 and 62 (as well as their dependent claims) are also nonobvious over Gillman. None of other cited references (Force, Godin, Pepin and Fickes) cures this defect of Gillman.

Independent claims 25, 31 and 55:

Applicants have canceled independent claims 25, 31 and 55. The rejection of independent claims 25, 31 and 55 (as well as their dependent claims) under 35 U.S.C. § 103(a) is thus moot now.

Reconsideration and withdrawal of the rejection of amended independent claims 1, 61 and 62 as well as their dependent claims under 35 U.S.C. § 103(a) are thus respectfully requested.

CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' representative at (612) 373-6900 to facilitate prosecution of this application. If necessary, please charge any additional fees or deficiencies, or credit any overpayments to Deposit Account No. 19-0743.

Respectfully submitted,

SCHWEGMAN, LUNDBERG & WOESSNER, P.A.
P.O. Box 2938
Minneapolis, MN 55402--0938
(612) 373-6900

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By / Nathan P. Elder /
Nathan P. Elder
Reg. No. 55,150

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 11th day of August, 2009.

Chris Bartl
Name

/ C. Bartl /
Signature